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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/814,243

03/21/2001

Edmund H. Louie

JPC-006

2002

70813

7590

05/16/2008

GOODWIN PROCTER LLP
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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

05/16/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/814,243	Applicant(s) LOUIE ET AL.	
	Examiner OLABODE AKINTOLA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-55 is/are pending in the application.
- 4a) Of the above claim(s) 45-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted amended claims 45-55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The system of Claim 34 is distinct from the system of claim 45.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-55 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 34-36, 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengal et al (USPN 5940812) (hereinafter referred to as Tengal) in view of Atkins (USPN 4953085) (hereinafter referred to as Atkins) in view of Walker et al (USPN 6484153) (hereinafter referred to as Walker) in view of Rutter, J (Deals in Cyberspace, Euromoney, London, Feb. 1998) (hereinafter referred to as Rutter) and further in view of Cyber street (Wall Street and Technology, New York, June, 1997) (hereinafter referred to as CyberStreet).

Re claim 34: Tengal teaches a client server-based loan management system for managing loans, comprising:

a borrower interface for accessing the system over a communication network (Fig. 1, RN {104}, col. 2, lines 33-36);

a borrower management module accessible via the borrower interface and storing therein borrower information including at least borrower contact information, funds transfer instructions, and a borrower fee schedule (Fig. 1, RN {110}, col. 2, lines 38-45);

an investor interface for accessing the system over a communication network (Fig. 1, RN {102}, col. 2, lines 59-61);

an investor management module accessible via the investor interface and storing therein investor information including at least investor contact information, funds transfer instructions, and tax information (Fig. 1, RN {110}, Fig. 7, col. 2, lines 64-67);

a syndicate manager interface for accessing the loan management system over a communication network (Fig. 1, RN {111}, col. 2, lines 59-61).

Tengel does not explicitly teach a transaction management module for maintaining information corresponding to particular transaction; a loan management module comprising sub-modules; and a report module as recited in the claim.

Atkins teaches a transaction management module for maintaining information corresponding to particular transaction (col. 12, lines 15-39); and a report module in communication with other modules (col. 12, lines 40-55; col. 19, lines 64-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengal to include a transaction management module and a report module. One would have been motivated to do so in order to receive, store and monitor records of transactions for reporting to appropriate entities.

Walker teaches a borrower interface, an investor interface and a central controller that manages the transaction between the borrower and the investor. The central controller (loan management module) includes several databases (sub-modules) for different functions in communication with one another (abstract, Fig. 1-8, col. 5 lines 65- col. 7, line 67). Walker does not specifically teach syndicate loan sub modules and facility management sub module. However, Rutter teaches a loan management module and a reporting module to manage and monitor syndicated loans from signing to maturity catering for the whole life-cycle of the loan (paragraphs 3-5). Also

CyberStreet teaches a database that stores information about syndicated deals (paragraph 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengal's central processor (109) to include these databases as taught by Walker, Rutter and

CyberStreet. One would have been motivated to do so in order to have various functions assigned to the various databases, thereby enhancing the system's functionality.

Re claim 35: Tengel does not explicitly teach a loan portion ownership transfer module operable to inform lenders in said loan management system of a first lender offering a loan portion for at least one of a sale and a trade; said module being further operable to consummate said at least one of said sale and said trade, whereby recordation of a transfer of said loan portion ownership is made in said loan management system; and said transfer module is further operable to notify said first lender and an other party to said transfer of consummation of said transfer. Official notice is hereby taken that it is old and well known in the art to have modules that offer loans for at least one of a sale and a trade. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tengel to include these steps, because it greatly improves the efficiency of the system by allowing lenders to build liquidity and support additional lending. Support for this Official notice can be found in *McClelland et al (US 5689650) at col. 2, lines 2-8.*

Re claim 36: Tengel teaches business logic module including stored criteria for determining if parameters of a transaction are within appropriate value ranges, wherein said business logic is operable to receive and analyze a transaction request from said user through said user interface and operable to approve said transaction request based on said criteria (see abstract, Figs. 2A, RN {202}, 3A).

Re claim 40: Tengel teaches a contact list including contacts for said plurality of lenders and for said at least one borrower (abstract, Fig. 7, col. 10, lines 27-33).

Re claim 41: Tengel teaches an external data system coupled to the loan management system, wherein a user can provide instructions to loan management system through said user interface module to access said external data system; and said access to said external data system can be used to compare said loan information with external data, and import and export data to and from the loan management system (Fig. 1, RN {116, 117}).

Re claim 42-44: Tengel teaches generating messages to at least one of said plurality of lenders, said at least one borrower and at least one contact related to said plurality of loan resources; wherein said generated messages must be approved and released for transmission by a user having approval and release authorization; wherein said generated messages contain all information needed to initiate a loan for use as one of said plurality of loan resources; wherein said generated messages contain all information needed to initiate a loan for use as one of said plurality of loan resources (abstract).

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Atkins in view of Walker in view of Rutter in view of CyberStreet and further in view of Norris (US Patent 5940811) (hereinafter referred to as Norris).

Re claim 37: Tengel does not explicitly teach wherein the investor management module further comprises: a set of funds transfer instructions for each of said plurality of lenders; and each of said funds transfer instructions having a status indicative of whether said funds transfer instructions are pending or approved.

Norris teaches wherein the investor management module further comprises: a set of funds transfer instructions for each of said plurality of lenders; and each of said funds transfer instructions having a status indicative of whether said funds transfer instructions are pending or approved (col. 4, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tengel to include these steps as taught by Norris because providing said instructions allow for easier and faster movement of funds within the system as well as eliminating bias in the decision to approve or deny the loan.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Atkins in view of Walker in view of Rutter in view of CyberStreet and further in view of CFO Alert ("New Medium Brewing For Syndications") (hereinafter referred to as CFO).

Re claim 38: Tengel does not explicitly teach an agent fee calculation module operable to calculate an agent fee; and said agent fee related to at least one of transactions for and amounts of said loan resources. CFO teaches an agent fee calculation module operable to calculate an agent fee; and said agent fee related to at least one of transactions for and amounts of said loan resources (Pg. 1, lines 59-61). It would have been obvious to one of ordinary skill in the art at the

time of the invention to modify Tengel to include this step as taught by CFO. One would have been motivated to do this in order to allow the agent receive payment for his services.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Atkins in view of Walker in view of Rutter in view of CyberStreet and further in view of Nickles (USPN 6134591).

Re claim 39: Tengel does not explicitly teach a user access authorization module; and an access authorization level assigned to said user, whereby said user is granted access to various portions of said loan management system based on authorization accorded to said user by said user access authorization module determined by said access authorization level. Nickles teaches a user access authorization module; and an access authorization level assigned to said user, whereby said user is granted access to various portions of said loan management system based on authorization accorded to said user by said user access authorization module determined by said access authorization level (col. 6, lines 7-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tengel to include these steps as taught by Nickles so that different users can have varying levels of access based on their user identifications and passwords.

Response to Arguments

Applicant's arguments filed on March 31, 2008 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the preamble “a client server based loan management system for managing syndicated loans”, the recitation “a client server based loan management system for managing syndicated loans” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant also argues that Tengel fails to teach syndicate manager interface. Examiner respectfully disagrees. The syndicate manager interface is interpreted simply as an interface. Examiner notes that the claim in its present form is interpreted as comprising of plurality of interfaces for accessing a system over a communication network. The different labels attached to each of the interfaces are considered non functional. An interface is an interface regardless of whether it is called a borrower interface, an investor interface or a syndicate manager interface. Tengel teaches plurality of interfaces for accessing the system over a communication network. Also, the different labels attached to the modules and sub modules are considered non functional. They are simply interpreted as database(s) for storing specific information (also considered non functional). Regarding a loan management module, the Walker reference was cited to teach the concept of a module comprising plurality of sub modules.

In response to applicant's argument that Tengel teaches away from incorporation of additional module (transaction management), Examiner respectfully disagrees. One of ordinary skill in the

art would recognize the advantage of incorporating additional modules to Tengal for additional functionalities such as receiving, storing and monitoring records of transactions for reporting to appropriate entities. Atkins was cited for teaching the concept of storing transaction information and generating reports from different databases.

Examiner notes that the claim is directed to a system. System claim is defined by the structure (elements and their functional relationships) and not the intended use of each element in the structure. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691